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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/187,749 11/09/98 UTSUMI K 1080.1067/JD

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LM02/0426

EXAMINER

IRSHADULLAH, M

ART UNIT

PAPER NUMBER

2765

DATE MAILED:

04/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/187,749

Applicant,
Utsumi et al.

Examiner
M. Irshadullah

Group Art Unit
2765



☒ Responsive to communication(s) filed on Nov 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: .

The disclosure is generally narrative and indefinite/lack clarity, failing to conform with current U.S. practice. The same appear to be a literal translation into English from a foreign document and are replete with grammatical, idiomatic and other errors. For instance:

- a) Page 1, “ Recently, it becomes..... how the copyright is..... protected.”, should be “Recently, it has become..... how the copyright be protected ”.
- b) Page 1, “ and when....., the book is passed into the buyer,.....”, should be “ and when..... , the book passed to the buyer,..... ”.
- c) Page 2, line 9 “ apparatuses ”, ought to be “ apparatus ”.
- d) Page 4, “ alternatively it is acceptable.....encrypted with the first media information, is addressed as the first encryption secure information. ”, should be “ alternatively it is acceptablethe first media ID..... is called/named/termed as the first encryption secure information ”.
- e) Page 4, “ This is a similar as to the matter of the above-mentioned ”, should be “ This is similar to the matter (as) mentioned above ”.

Similar translation/construction/grammatic problems are noticed throughout the disclosure.

- f) Numbering of lines would have made it easier to refer to the forementioned problems.

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Detailed editing and appropriate corrections are appreciably required for the benefit of the Patent Community.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The claims are generally narrative and unclear/ambiguous/indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical, constructional and idiomatic errors.

For instance, page 2, lines 5-7 read: “ as a document, a picture and a program, which are digitalized, while contributing to a protection of the copyright for the contents.”, would read better if narrated as: “ as a document,....., which are digitized, while protecting the copyright of the contents ”.

Writing of claims in clear/precise manner is appreciably required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al (US Patent 5,553,139).

Ross et al disclose:

Claim 1. A license devolution apparatus [Title and col 1, lines 7-8] wherein a first storage medium for storing therein contents encrypted with a predetermined key [Fig. 6B described col 1, lines 46-51, Fig. 5 (Enabler Keys), Fig. 2 (210, 216, 218) recited with col 6, lines 1-3, 8-13, 16 and 19-20. It needs be mentioned that the use of a predetermined (enabler) key or a key generated during encryption process are notoriously known in the art under discussion], a first media ID for identifying one's own self, and a first encryption secure information on which the key and a first use information representative of a right of using as to the contents are encrypted together with one another or individually with the first media ID, and a second storage medium for storing therein a second media ID for identifying one's own self are accessed so that the right of using as to the contents stored in said first storage medium is devolved from said first storage medium to said second storage medium [Col 6, lines 49, col 1, lines 51-54 read with lines 37-38 (serial number/ID and application/content of first media/CD and by the same token

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another serial number/ID and application program/content relating to second media/diskette), and col 6, line 40-49 together with lines 52-54], said license devolution apparatus comprising:

decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first use information [[Col 4, lines 22-24, col 6, lines 40-59 (specifically line 49, 52-56), col 7, lines 28-40, 47-55, Fig 4 described col 7, lines 56-65 continue col 8, lines 5-8, and Fig. 7 (C, D, E)]; and

encryption means for encrypting the key obtained through decoding by said decoding means and a second use information representative of a second right of using in which a first right of using represented by the first use information obtained through decoding by said decoding means is transferred or distributed, together with one another or individually with the second media ID to generate a second encryption secure information into storage in said second storage medium [Fig 2 (210, 218), Fig. 5 (A, B), col 3, lines 17-24, col 6, lines 40-49 and 51-52 recited with col 4, lines 8-15, col 3, lines 34-45 and col 7, lines 32-55].

Claim 2. A license devolution apparatus according to claim 1, wherein said encryption means encrypts a third use information representative of a third right of using obtained through subtracting the second right of using from the first right of using, or both the key and the third right of using with the first media ID, and write encrypted ones into the first storage medium, so that the first storage medium stores therein-a third encryption secure information in which both the key and the third use information are encrypted with the first

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media ID, instead of the first encryption secure information [Fig. 2 (210, 218), Fig 5 (A, B), Fig. 5 (any of 2-4 would be considered as third user of the third right of using and obtained by eliminating/subtracting the second right of using from the first right of using) and col 3, lines 40-45].

Claim 3. A license devolution apparatus according to claim 1, wherein in the event that entire rights of using as to the contents, to which the first storage medium is entitled, are devolved to the second storage medium, said encryption means generates the key obtained through decoding by said decoding means and the second use information in which the second use information representative of the second right of using succeeded to the first right of using in its entirety is encrypted, into storage in the second storage means, and destroys the key constituting the first encryption secure information stored in the first storage medium [Claim 1, lines 37-41, col 4, lines 8-15 and col 6-col 7(upto line 20)].

Claim 4. A license devolution apparatus according to claim 1, wherein before devolution of the right of using as to contents, the first storage medium stores therein encrypted contents as to which the right of using is intended to be devolved [Figs. 6A and 6B described col 1, lines 31-61], and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents of interest in devolution stored in the first storage medium, and

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storing in the second storage medium the contents thus read in form of an encryption [Claim 1, lines 37-41. Reading devices, like diskette or CD drives are inherently implied].

Claim 5. A license devolution apparatus according to claim 1, wherein the first use information and the second use information are representative of the presence of the right of using, and the third use information is representative of the absence of the right of using [Fig. 7, any of 2-4 would be a first (user) of first use information, a second (user) of second use of information and when two are using the use information, third one (say, installer) would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all].

Claim 6. A license devolution apparatus according to claim 1, wherein the first use information is representative of a first available number of times or available time, the second use information is representative of a second available number of times or available time which is less than the first available number of times or available time, and the third use information is representative of a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time [Inherently implied, since the user under the agreement would be obliged to use the product (document, picture or program) for certain number of time(s) and

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when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times].

Claim 7. A license devolution apparatus according to claim 1, further comprising a first drive and a second drive for driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware for accessing the first storage medium and the second storage medium, respectively [Inherently implied; the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same],

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit; and wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive [Inherently implied; each driver (software/firmware) would be able (have authority) to run its respective media having a serial number/ID and access the information on it].

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Ross et al., US Patent 5,903,650. Method And Apparatus For Electronic License Distribution.

B) Saito et al., US Patent 5,848,158. Data Copyright Management System.

C) Saito, US Patent 5,646,999. Data Copyright Management System.

E) Medveczky et al., US Patent 5,182,770. System And Apparatus For Protecting Computer Software.

F) Corbin, US Patent 5,138,712. Apparatus And Method For Licensing Software On A Network Of Computers..

G) Kubota, US Patent 5,034,980. Microprocessor For Providing Cop Protection.

H) Arnold et al., US Patent 4,558,176. Computer Systems To Inhibit Unauthorized Copying, Unauthorized Usage, And Automated Cracking Of Protected Software.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683. The examiner can normally be reached on M-F from 10:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached on (703) 305-9708. The fax number for the organization is (703) 305-0040/308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.



M. Irshadullah

April 20, 2000



ERIC W. STAMBER
PRIMARY EXAMINER